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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,885	10/17/2001	Robert B. Haines	10013718-1	7082

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EXAMINER	
DICUS, TAMRA	
ART UNIT	PAPER NUMBER
1774	

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/981,885	HAINES, ROBERT B.	
	Examiner	Art Unit	
	Tamra L. Dicus	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 6-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 31-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The Examiner withdraws the objections to claims 37 and 38 due to Applicant's amendment. The Examiner acknowledges compliance with the amendment. The 112 rejection is withdrawn due to printing on an edge is known in the art.

Claim Objections

1. Claims 1-2, 32, are objected to because of the following informalities: "a facial portion of the facial portions" and "an edge portion of the edge portions" does not make sense. Appropriate correction is required. The Examiner suggests substituting "a facial portion," "an edge portion".
2. Claim 31 is objected to because of the following informalities: "the data comprises *in the* single fluid-based marking *is for* configuring" is grammatically incorrect. Appropriate correction is required.
3. Claims 2-3 are objected to because of the following informalities: "a single *respective* fluid-based marking" is not consistent with the language of claim 1 e.g. "a single fluid-based marking". Appropriate correction is required. The Examiner suggests changing claim 1 to incorporate "respective" or omit "respective" from claims 2-3 for clarity.
4. Claims 2 and 34 are objected to because of the following informalities: "individual ones of the fluid-based markings" is grammatically incorrect. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites “the single respective fluid-based marking was imprinted on the edge portion and not imprinted on the facial portion”. This is confusing and appears contradictory, as claim 3 depends on claim 1 that states “the single fluid-based marking being on a facial portion of the facial portions **and** on an edge portion of the edge portions”. Based on this contradiction, claim 3 could be a different invention and would be distinct from claim 1, thereby requiring a restriction.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4, 31-34, and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4278722 to Hoppe et al. in view of USPN 6582138 to Meunier et al.

9. Hoppe discloses a multilayer edge sealed record carrier of paper and film. Hoppe employs a printed sheet of paper (inherently having top and bottom facial portions) having a print of identification data (equivalent to “media parameters” of instant claim 32) that extends without interruption from the paper surface and film over the edge (col. 4, lines 60-68 of Hoppe) (equivalent to the marking of a face being perpendicular and adjacent to an edge). Hoppe does not disclose the printed identification data is of a single-fluid marking such as ink (instant claim 4) or that the marking is a barcode (instant claim 33) or that there are a plurality of sheets (instant claims 5, 38, and 39). Meunier teaches an authenticated sheet material using printed ink. Meunier discloses marking an edge of the sheet or sheets of material with indicia arranged to form a unique code identifying the sheet of material, wherein the sheet of material includes a first surface, a second surface disposed opposite the first surface and an edge extending between the first surface and the second surface and peripherally about the sheet of material (col. 2, lines 45-68, col. 4, lines 25-30, col. 6, line 54, and col. 7, lines 20-21 and lines 45-55 of Meunier). The edge marking is of visible or invisible ink (col. 3, lines 3-5 of Meunier) and has been printed or recorded with information (col. 7, lines 45-46 of Meunier) (instant claim 37). Meunier shows a ream identifier (22) (barcode) on stacks of sheets of paper (ream 20) and a single sheet of paper in Figure 2 and Figures 6 and 8. Meunier and Hoppe are analogous art because both references are in the same field of endeavor, such as the coded sheet technology. It would have been obvious to one of ordinary skill in the art to include the ink, barcode, and the plurality of sheets of Meunier to the multilayer carrier of Hoppe because Meunier provides printed ink and a barcode on a sheet or a plurality of sheets for the purpose of identifying the sheet and for use in documents such as magazines or books for identifying the plurality of sheets when used in

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storage and retrieval (col. 7, lines 45-50 and col. 10, lines 50-51 of Meunier). With respect to the limitation “for configuring operations to form images...” (instant claims 1-2 and 31) is not given patentable weight because it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647.

Further to instant claim 3, that “the single respective fluid-based marking was imprinted on the edge” is not a positive recitation. To the fluid-based marking having bled onto the facial portions is inherent as the ink is printed onto the surface of the sheet(s).

To claim 34, because the prior art does not expressly disclose a sheet having sufficient capillary action properties to carry the fluid-based marking, the Examiner interprets that the sheet of the prior art does not have sufficient capillary action.

To claims 35-36, that the fluid-based marking was generated in part as a function and positioning of a mask, where the mask having been placed over the sheet and having been offset at an angle of skew are process limitations in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps.

Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

Both Applicant's and prior art reference's product are the same. Further, the mask is not part of the sheet media, the mask is not adding any positive recitation to the claims.

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To claim 39, that each of the sheets are being skewed at an angle is a process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Response to Arguments

No arguments were recently submitted from Applicant with the non-compliance correction filed 1-29-04. A new rejection is submitted above.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 6335084 to Biegelsen et al. teaches encoded sheet material having bar codes on an edge of a sheet(s). USPN 6604875 and 6499665 to Meunier et al. teaches an authenticated sheet material and method for indexing. USPN 5148187 to Ono et al. teaches printing apparatus with sensor to print on the edge of a sheet. USPN 554432 to Sandor et al. teaches press polarization of lenticular images.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tamra L. Dicus
Examiner
Art Unit 1774

May 3, 2004

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

